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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/653,792

09/03/2003

Irving R. Michlin

6924

7590 11/30/2007
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EXAMINER

PASCUA, JES F

ART UNIT

PAPER NUMBER

3782

MAIL DATE

DELIVERY MODE

11/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/653,792

Applicant(s)

MICHLIN ET AL.

Examiner

Jes F. Pascua

Art Unit

3782

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 22, 23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 11, 12, 30 and 31 is/are allowed.
- 6) ☒ Claim(s) 4-10, 22, 23, 25-29, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 4-10, 22, 23 25, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,389,414 to Popat.

Popat discloses a blank (20) comprising a sheet of paper (46) having a first transverse line of weakening (30), a second line of weakening (32) transverse to the first line of weakening. Popat discloses that the sheet into quarters along lines of weakening (30, 32) (column 4, lines 26-29). This meets the recitation "a first transverse line of weakening to divide said sheet into half". The lines of weakening divide the sheet into four areas. Each of the areas include die cut, removable sections (62) that are each respectively spaced apart from an adjacent removable section on an opposite side of each line of weakening. The blank further comprises a layer of adhesive (49) on each of the sections and a removable liner (48) disposed over the adhesive.

Having met the structure of applicant's claimed device, the blank of Popat is considered to be capable of: "making at least one laminated novelty product", "receiving imaging" on a first removable section, "receiving imaging" on a second removable section "related to the imaging on said first section", "folding of said first and second said section over each other to allow said adhesive to laminate said first removable section with said second removable section" in "back-to-back relation" and "folding over" a fourth section "onto said removable section of said third area".

Regarding claim 10, Popat discloses the paper of the blank may be made of "card stock" to form business cards. The card stock disclosed by Popat is considered to be sufficiently broad so as to include card stock materials that are of "photo quality" and "water resistant".

3. Claims 26-29 rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,514,587 to Fernandez-Kirchberger et al. See Fig. 4B.

As a note, the adhesive (8.4) of Fernandez-Kirchberger et al. is shown as being smaller than the area of the sheet on the left side of the fold line (4.4). Therefore, portions of the area outside the adhesive would not be laminated to the area on the right side of the fold line. Fernandez-Kirchberger et al. meets the recitation "an adhesive only on one of said sections...without laminating the remainder of said first area to said second area" to the same degree applicant sets forth the metes and bounds of "the remainder of said first area".

Allowable Subject Matter

4. Claims 1-3, 11, 12, 30 and 31 allowed.

Response to Arguments

5. Applicant's arguments filed 06/25/2007 have been fully considered but they are not persuasive.

Applicant remarks, "the Examiner has not established that the blank of Popat is capable of the requirements of claim 4." However, there is nothing in applicant's remarks that indicate that the claimed blank structure is different than the label sheet of Popat. Due to the structural similarities between the Popat label sheet and applicant's claimed blank, the Examiner maintains that Popat is capable of "making at least one laminated novelty product", "receiving imaging" on a first one of the removable label sets (62) and "receiving imaging" on another one of the removable label sets that is "related to the imaging" on the first one of the removable label sets. Furthermore, the lines of weakening (30, 32) make the Popat label sheet capable of "folding" two of the subsections (22-28) over each other to allow the adhesive (49) to laminate two of the label sets (62) in "back-to-back relation" and "folding over" a third label set "onto" fourth label set. Therefore, the Examiner has correctly found that Popat established a prima facie case of anticipation. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).

6. Applicant's arguments with respect to claims 26-33 have been considered but are moot in view of the new ground of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims

"define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Jes F. Pascua".

Jes F. Pascua
Primary Examiner
Art Unit 3782

JFP